

REMARKS:

Claims 1-35 are currently pending in the subject Application.

Claims 1-35 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,076,080 to Morscheck et al. (hereinafter “*Morscheck*”) in view of U.S. Patent No. 6,014,644 to Erickson (hereinafter “*Erickson*”).

Applicant notes with thanks the Examiner’s response of 23 June 2010 and the Advisory Action of 15 September 2010. Applicant further notes with thanks the Examiner’s statement in the Advisory Action of 15 September 2010, that Applicant’s amendments in the response pursuant to 37 C.F.R. § 1.116 filed 23 August 2010 raise new issues that would require further consideration and/or search.

Applicant respectfully submits that all of Applicant’s arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner’s rejections. No new matter has been added.

I. Support for Current Claim Amendments

In compliance with 35 U.S.C. § 112, Applicant respectfully submits that support for Applicant’s current claim amendments may be found in at least paragraph 23 and FIG.’s 2A-B of Applicant’s specification, as published, provided below for the Examiner’s convenience:

[0023] FIG. 2 illustrates an example directory structure 44 of an example GCD 42 for product classes. Products and documents categorized in GCD 42 may be organized according to schemas. *A schema may include a set of product classes (which may be referred to as a “taxonomy”) organized in a hierarchy.* Each class may be associated with a set of product features, characteristics, or other product attributes (which may be referred to as a “product ontology”) and/or with a set of

document features, characteristics, or other document attributes (a “document ontology”) for each product type. For example, pens may have different kinds of tips (such as ball point or felt tip), different tip sizes (such as fine, medium, or broad), and different ink colors (such as blue, black, or red). In addition, felt pens may have certain documents associated with them while ball point pens may have different documents associated with them. Accordingly, a schema may include a class corresponding to pens that have a product ontology including tip type, tip size, and color, or other appropriate attributes as well as documents for pens and specific pen types. Within a class, products may be defined by product attribute values (such as, for example, ball point, medium tip, blue ink). Reference to “value” is meant to include any appropriate data reflecting an instance of a product attribute or a seller attribute. Product attribute values and seller attribute values may include numbers, letters, figures, characters, symbols, or other suitable information for describing a product or a seller, respectively. In one embodiment, a product ontology may be divided into entry-required attributes (meaning attributes for which a value has to be provided) and entry-optional attributes (meaning attributes for which a value is optional), and these categories may be further divided into commercial features and design features (or any other suitable divisions).

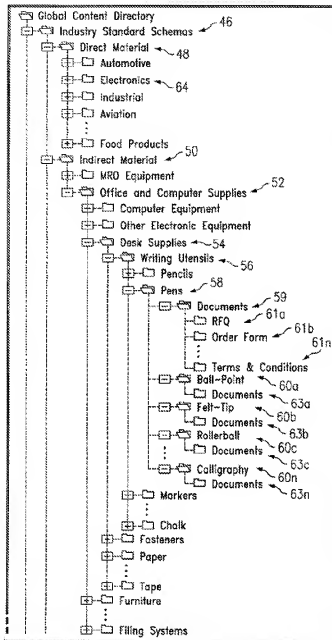


FIG. 2A

44

TO FIG. 2B

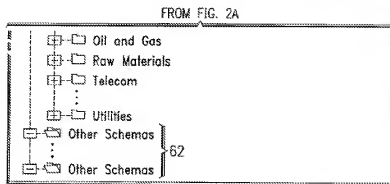


FIG. 2B

44

II. Rejections Under 35 U.S.C. § 103

Claims 1-35 stand rejected under 35 U.S.C. § 103(a) over *Morscheck* in view of *Erickson*.

Applicant respectfully submits that Claims 1, 11, 23, and 35 in their prior, unamended form contain unique and novel limitations that are not disclosed in *Morscheck* and *Erickson*, whether taken individually or in combination. However, in an effort to expedite prosecution of the Subject Application, Applicant submits current claim amendments to more distinctly point out that which Applicant claims as the invention. Thus, Applicant respectfully traverses the Examiner's obviousness rejection of Claims 1-35 under 35 U.S.C. § 103(a) over the proposed combination of *Morscheck* and *Erickson*, either individually or in combination.

In rejecting Claim 1, the Examiner states the following:

The Examiner then turns to *Erickson* to teach a *plurality of classes organized in a hierarchy, each class is categorized and associated with one or more attributes*. *Erickson* teaches a central database which is accessed via classifications or any other manner that allows easy access by a buyer or supplier to the information stored in the central database (col. 7, lines 14-17). The central database serves as a repository for useful information to locate goods or services of interest (col. 7, lines 65-67). Classification information may also be submitted illustrating types or classes or services or goods provided by a particular company (col. 7, lines 50-52). *Erickson* teaches the linking products and services to a class which will help locate groups or classes of products or services available (col. 9, lines 47-49). “*Classification*” is defined as “*systematic arrangement in groups or categories according to established criteria*”. “*Class*” is defined as “*rank*”; “*a group, set,*

or kind sharing common attributes”; and “a division or rating based on grade or quality”. (Merriam Webster Collegiate Dictionary”, Tenth Edition, 1997).

Such central database of Erickson which is accessed via classification; central database which serves as a repository for useful information to locate goods or services of interest; classification information illustrates types or classes provided by a particular company; linking products and services to a class which will help locate groups or classes of products or services available; and *definition of classification and class are considered “a plurality of classes organized in a hierarchy*, each class categorizing the plurality of document and associated with one or more attributes of the plurality of documents categorized in the class.”

(23 June 2010, Final Office Action, pages 7-8). (Emphasis added). For reasons previously made of record, Applicant respectfully disagrees with the Examiner’s assertion that *Erickson* discloses “*a global content directory including a plurality of classes organized in a hierarchy, each class categorizing the plurality of documents and associated with one or more attributes of the plurality of documents categorized in the class,*” as previously required by Claim 1, in its prior, unamended form. However, to expedite prosecution and allowance of the Subject Application, Applicant has currently amended the claim to more clearly and distinctly point out that which is meant by the term “hierarchy” as recited in Applicant’s claims. Thus, Applicant respectfully submits that Erickson also fails to disclose “*a global content directory including a plurality of classes organized in a hierarchy having an inverted tree structure,*” as required by Claim 1, as amended.

Applicant respectfully draws the Examiner’s attention to column 7, lines 46-67 of the specification of *Erickson*, provided below, on which the Examiner relies:

Although the process of soliciting bids and collecting responses using the present is described in greater detail below, the process may be summarized as follows. Supplier 12 submits information to service provider 14 to be included in central database 16. Such information may include, for example, company profile information describing the company. *Classification information may also be submitted illustrating the types or classes of services or goods provided by a particular company.* Additionally, supplier 12 may also submit *information regarding the products, product lines, services, and the like offered by the supplier. Classification information for the products and/or services offered by a particular supplier may also be submitted.* In short, supplier 12 may submit any information into central database 16 that would be helpful for a buyer in locating and selecting supplier 12. In certain embodiments, it may be desirable to limit the type of information submitted by a supplier to a *predefined set of fields* in order to provide consistency and uniformity in central database 16. In other

embodiments, perhaps a *selected set of information* must be submitted with the option of submitting additional information as well. In the present invention, central database 16 serves as a repository for information useful in allowing buyer 10 to locate suppliers 12 that offer goods or services of interest.

(Emphasis added). Applicant respectfully submits that as shown above, the portion of *Erickson* relied upon by the Examiner fails to disclose at least “*a plurality of classes organized in a hierarchy having an inverted tree structure*, each class categorizing the plurality of documents and associated with one or more attributes of the plurality of documents categorized in the class” as required by Claim 1. Applicant further respectfully submits that *Erickson* merely discloses, among other things, classification information that may illustrate the types or classes of services or goods provided by a supplier and makes a general mention of “information regarding the products, product lines, services, and the like offered by the supplier.”

While the Examiner relies on dictionary definitions of “*classification*” and “*class*” to support the Examiner’s assertions, Applicant respectfully submits that the Examiner has overlooked the support that the definition of “*hierarchy*” lends to Applicant’s position. The term hierarchy as defined by various computing dictionaries, which provide a better indication of what the broadest reasonable interpretation of “*hierarchy*” may be in light of the specification, is “[a]n organi[z]ation with *few things, or one thing, at the top and with several things below each other thing; [a]n inverted tree structure,*” (*The Free On-line Dictionary of Computing*, Denis Howe, <http://dictionary.reference.com/browse/hierarchy>), of “(1) A form of organization resembling a *pyramid. Each level is subordinate to the one above it;* (2) An organization whose *components are arranged in levels from a top level down to a bottom level.*” (*Principia Cybernetica Web*, <http://pespmc1.vub.ac.be/ASC/HIERARCHY.html>).

Thus, in an effort to more distinctly clarify that which Applicant regards as the invention, Applicant submits the current claim amendments which indicate that in accordance with the commonly accepted definition of “*hierarchy*,” Applicant intends for the *hierarchy* as claimed to have an *inverted tree structure*. This structure is nowhere found in the portions of *Erickson* relied on by the Examiner. In fact, the portion of *Erickson* relied on by the Examiner is silent, and thus, fails to disclose any detail as to how any of this classification information is arranged in any manner and thus, fails to disclose at least the elements of a *plurality of classes organized in a hierarchy having an inverted tree structure*, as required by Applicant’s claims. In addition,

what *Erickson* calls classification information is simply an abstraction that describes information submitted by a supplier, which “may” or “may not” be stored in a particular manner into central database 16 by some undefined component of the *Erickson* system. Central database 16 of *Erickson* is essentially a **black box** that “may” or “may not” perform storing of information in a recited function. But how it does so is left undisclosed.

Thus, because, among other things, the Examiner fails to point to any specific disclosure of *Erickson* or *Morscheck* that discloses this element and does not offer any assertion that there is any suggestion to combine any of the teachings of *Erickson* and *Morscheck* to suggest that “*a plurality of classes organized in a hierarchy having an inverted tree structure*, each class categorizing the plurality of documents and associated with one or more attributes of the plurality of documents categorized in the class” would be obvious given the disclosures of these two references, Applicant respectfully submits that a rejection under 35 U.S.C. § 103 cannot be properly maintained. Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 103 be withdrawn.

III. The Final Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Morscheck-Erickson* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Morscheck* or *Erickson*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at __, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “*ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.*” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “*factual findings made by Office personnel are the necessary underpinnings to establish obviousness.*” (*id.*). Further, “*Office personnel must provide an explanation to support an obviousness rejection* under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Morscheck* and *Erickson*. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of *Morscheck*, to include global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by *Erickson*.” (23 June 2010 Final Office Action, Page 4). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Morscheck* and *Erickson*. *Applicant respectfully requests that the Examiner provide proper support for the*

obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill. Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. (Id.)*. In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. (Id. and See 35 U.S.C. 103(a)).*

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Morscheck, Erickson and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.* The Office Action merely

states that “in order to allow easy access to the information stored.” (23 June 2010 Final Office Action, Page 4). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Morscheck, Erickson and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art*. Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious*.” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit*.” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness*.”” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Morscheck and Erickson to render obvious Applicant's claimed invention*. The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of Morscheck, to include global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by Erickson" and "in order to allow easy access to the information stored," *do not adequately provide clear articulation of the reasons why Applicant's claimed invention would have been obvious*. (23 June 2010 Final Office Action, Page 4). In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obviousness rejection based on the proposed combination of *Morscheck* and *Erickson*, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines*.

III. Applicant's Claims are Patentable over the Proposed Morscheck-Erickson Combination

With respect to Claims 11, 23, and 35 these claims contain similar limitations and are thus, considered patentably distinguishable over the proposed combination of *Morscheck* and *Erickson* for at least the reasons discussed above in connection with Claim 1, as amended.

Furthermore, with respect to dependent claims 2-10, 12-22, and 24-34: Claims 2-10 depend from Claim 1; Claims 12-22 depend from Claim 11; and dependent Claims 24-34 depend from Claim 23 and are also considered patentably distinguishable over *Erickson*. Thus, dependent Claims 2-10, 12-22, and 24-34 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-35 are not rendered obvious by the proposed combination of *Morscheck* and *Erickson*. Applicant further respectfully submits that Claims 1-35 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-35 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-35 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$810.00 RCE fee, to Deposit Account No. 500777.** Although Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

23 September 2010
Date

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